Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte C. J. GONSALVES

Appeal No. 2001-1076
Application No. 09/231,677

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, FRANKFORT and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 4, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to horseshoes which attenuate vibration energy from the horseshoes to the leg of the animal (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Coleman	28,656	June 12, 1860
Phreaner	2,705,536	April 5, 1955

Claims 1 to 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Phreaner in view of Coleman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 9, mailed November 24, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper

No. 8, filed September 22, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 4 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

Claim 1, the sole independent claim on appeal reads as follows:

> In a U-shaped horseshoe having a central bight, an arm extending from each end of said bight, and a tip on the other end of each arm, said horseshoe including a metal shoe having a wear surface for contact with the ground and an oppositely facing flat surface, a flat resilient pad having a first surface facing and overlaying said flat surface of the shoe and a second flat surface on its opposite side to lay directly against the hoof, the improvement comprising: a recess in the flat surface of the metal shoe in each of said arms, spaced from each respective tip and located in the region near the tip where a nail cannot effectively be driven into the hoof when the horseshoe is nailed to the hoof, said recess having a wall, and a stud on said first surface of said pad, said stud being so proportioned as to fit closely in said recess in contiguity with the wall of the recess, and a layer of cement between and joining the flat surface of the metal shoe to the first surface of the pad, and the stud to the wall of the recess.

Thus, all the claims under appeal require a stud on the first surface of the pad with the stud being proportioned to

fit closely in the recess formed in the flat surface of the metal shoe located in the region near the tip where a nail cannot effectively be driven into the hoof when the horseshoe is nailed to the hoof and a layer of cement between and joining the stud to the wall of the recess. In our view, the only suggestion for modifying the applied prior art to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure.[1]

Coleman teaches a horseshoe in which the upper plate A, the lower plate B and the intervening elastic strip C are permanently connected together by any convenient number of plain or screwed rivets e. Thus, at best, it is our view that Coleman would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified the horseshoe of Phreaner to include any convenient number of plain or screwed rivets to permanently connect Phreaner's metal body 10 and laminated pad 11 together.

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[1] The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

However, this modification of Phreaner would not result in the claimed subject matter. In that regard, there is no teaching or suggestion in the applied prior art of (1) a stud on the first surface of the pad[2]; (2) a layer of cement between and joining the stud to a wall of a recess formed in the flat surface of the metal shoe[3]; and (3) the recess being located in the region near the tip where a nail cannot effectively be driven into the hoof when the horseshoe is nailed to the hoof[4].

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[2] A rivet passing through Phreaner's metal body 10 and laminated pad 11 is not readable on being a stud **on** the first surface of the pad.

[3] The examiner's position that Phreaner's cement A provided between the metal body 10 and the laminated pad 11 would seep into the recess (i.e., the hole provided in the metal body to accommodate the rivet) as well as the nail holes 14 is sheer speculation unsupported by any evidence. Phreaner teaches (column 3, lines 23-48) that the metal body 10 and the laminated pad 11 with cement A therebetween are firmly pressed together and heated in an oven to cure the cement to form an integrated horseshoe. Thus, any rivets suggested by Coleman may have either (1) replaced Phreaner's cement A provided between the metal body 10 and the laminated pad 11, or (2) been applied after the curing of the cement so that there would not be a layer of cement between and joining the rivet to a wall of a recess formed in the flat surface of the metal shoe.

[4] There is no teaching or suggestion in Coleman of locating a rivet in the region near the tip of the horseshoe

(continued...)

For the reasons set forth above, the decision of the examiner to reject claims 1 to 4 under 35 U.S.C. § 103 is reversed.

CONCLUSION

[4](...continued)
where a nail cannot effectively be driven into the hoof when the horseshoe is nailed to the hoof. In that regard, while Figure 2 of Coleman shows two rivets e closer to the tips of the horseshoe than the location of the nail holes a, it is our opinion that if a rivet can be driven through the layers forming the horseshoe then that location is a location where a nail can effectively be driven into the hoof when the horseshoe is nailed to the hoof.

To summarize, the decision of the examiner to reject claims 1 to 4 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH Senior Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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